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09/892,747	06/28/2001	Tatsuo Nomura	1035-332	3643
7590	05/18/2005		EXAMINER	
NIXON & VANDERHYE P.C. 8th Floor 1100 North Glebe Rd. Arlington, VA 22201-4714			KLINGER, SCOTT M	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,747	NOMURA ET AL.	
	Examiner	Art Unit	
	Scott M. Klinger	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 11 January 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-32 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-32 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Claims 1-32 are pending.

Claims 28-32 are new.

Response to Arguments

Note: Applicant's remarks are in **bold** text. Examiner's responses are indented.

... Oki *et al.* fails to disclose confirming. In connection with this feature, the office action refers to Figure 5 of Oki *et al.*.... this portion of Oki *et al.* merely signifies completion of software installation, not confirmation that the newly installed software will operate when executed ...

The purpose of the system of Oki is to download new software to be executed on the client. Executing the software is inherently implied in the system of Oki. "*Executing the software*" is functionally equivalent to "*executing the software to thereby confirm operation of the program*". Executing the software inherently confirms the operation of said software.

... Alexander *et al.* fails to disclose or suggest the concept of confirming that a program is operable in a user system prior to payment as set forth in claims 8, 22 and 25 ...

Claims 8, 22 and 25 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Oki in view of Alexander. The system of Oki shows the step of judging if the program is operable in the user system prior to downloading it: "*The circumstance checking unit compares the circumstance information received from the circumstance information informing unit with that of the target software to check whether or not they are compatible, and informs the installing unit of the check result thus obtained. The*

installing unit decides whether or not the target software is to be distributed and if so, it determines a software distributing method, in response to the check result.” (Oki, col. 2, lines 37-44). The step of confirming that the program is operable in a user system would therefore occur before the payment is made.

... Claim 21 was rejected under 35 U.S.C. Section 102(b) as allegedly being anticipated by Platt ... Applicants find no disclosure of Platt of, for example, confirming that a program is operable in the user system as specified in claim 21 ...

Platt clearly shows an operation judging means for judging whether a program can be operated or not in the operating environment of the user system received via the server-side communication means:

“In the same manner as block 812 checked the hardware and limits the installation to certain types of hardware, block 816 limits the installation to certain types and levels of operating systems.” (Platt, col. 6, lines 32-36)

Platt, Fig. 8 shows checking the operating system level at step 816 and generating an error message if it won’t operate on the user system

... Claims 23 and 24 likewise call for confirming the operation of a program and are therefore not anticipated by Oki et al. Here again, the confirming of decompression, moving/re-naming files and registration signify only the successful installation of a program. Such installation does not constitute a confirming that the program will operate

...

The system checks to make sure the software to be downloaded can run on the client. Confirmation of a successful installation is equivalent to confirmation that the program will operate.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 12-21, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Oki (U.S. Patent Number 5,859,969, hereinafter “Oki”). Oki discloses a remote installation system and method. Oki shows:

In referring to claim 1,

- Transmitting an operating environment of the user system from the user system via the network to the server before supplying the program:

“The circumstance information informing unit obtains circumstance information relating to software operation circumstances in the terminal equipment and informs the distributing center of them.” (Oki, col. 2. lines 33-36)

- Judging whether the program is operable or not in the operating environment, and transmitting a result of the judgment from the server via the network to the user system:

“The circumstance checking unit compares the circumstance information received from the circumstance information informing unit with that of the target software to check whether or not they are compatible, and informs the installing unit of the check result thus obtained. The installing unit decides whether or not the target software is to be distributed and if so, it determines a software distributing method, in response to the check result.” (Oki, col. 2, lines 37-44)

- Executing the program on the user system after the program is supplied from the server and installed on the user system to thereby confirm operation of the program:

The purpose of the system of Oki is to download new software to be executed on the client. Executing the software is inherently implied in the system of Oki

In referring to claim 2,

- Displaying the result of the judgment as to whether the program is operable or not in the operating environment of the user system:
"The installing menu display unit displays plural methods of installing the target software." (Oki, col. 3, lines 45-46)

In referring to claim 3,

- Transmitting an order for the program from the user system via the network to the server when the program is judged to be operable:
Oki, Fig. 4 shows selecting a program **S12**, checking if the program is operable at **S14**,
Fig. 5 shows transmitting the selected program at **S18**

In referring to claim 4,

- Generating a program list made up of programs which can be supplied from the server; transmitting the program list from the server via the network to the user system; selecting a program from the program list:
"When the user inquires of the host computer 21 for the keyword lists through the terminal 23, the host computer 21 transmits' the first and second key tables 32 and 33 successively and displays keywords included in them on the display 24 of his terminal 23. The user selects the displayed keywords which corresponds to the target software and informs the host computer 21 of his selection." (Oki, col. 5, lines 14-20)

In referring to claim 5,

- Generating by the server a program list made up of programs which can be operated in the operating environment of the user system; transmitting the program list from the server via the network to the user system; selecting a program from the program list:
Oki, col. 5, lines 14-20 (see full quote above)

In referring to claim 6,

- Storing the result of judgment as data of the user system in the server when the program is judged to be inoperable:
Storing the result of a judgment made in a server is inherently implied in a server that conducts said judgment

In referring to claim 7,

- Expanding functions of the user system when a program supplied from the server via the network to the user system is installed:
Expanding functions of a user system by installing a program is inherently implied in a system in which a program is installed in a user system

In referring to claim 12,

- Said user system includes operating environment judging means for judging an operating environment of the user system, and before having a program supplied, transmits the judged operating environment via the network to the server:

Oki, col. 2, lines 33-36 (see full quote above)

- Said server includes operation judging means for judging whether the program is operable or not in the received operating environment, and transmits a result of judgment as to whether the program is operable or not via the network to the user system:

Oki, col. 2, lines 37-44 (see full quote above)

- Said user system is operable to Execute the program on the user system after the program is supplied from the server and installed on the user system to thereby confirm operation of the program:

The purpose of the system of Oki is to download new software to be executed on the client. Executing the software is inherently implied in the system of Oki

In referring to claim 13,

- Operation input means to be operated by a user; said user system is activated in response to operation on the operation input means:
"The selecting unit enables each user to select one or more keywords, which correspond to the target software, from those displayed by the keyword display unit, and inform the installing unit of them. The installing unit retrieves the target software from plural software, using the one or more keywords received." (Oki, col. 2, lines 27-32)
- Display means for displaying data; displaying the result of judgment given by the operation judging means of the server on the display means:
Oki, col. 3, lines 45-46 (see full quote above)
- The user system transmits the operating environment judged by the operation environment judging means via the network to the server:
Oki, Fig. 3 shows judging the operation environment at steps **S1** and **S2**, and then transmitting them at step **S3**

In referring to claim 14,

- Said user system orders the program to the server when the result of judgment received from the server indicates that the program is operable:
Oki, Fig. 4 shows the user orders the program after the judgment (circumstance check)

In referring to claim 15,

- Said server further includes storing means for storing data of the user system:
Receiving user data and running a script on said user data (Oki, Fig.4, **S14** and **40**) inherently implies a storing means to store said user data

In referring to claim 16,

- Said user system expands its functions when a program supplied via the network from the server is installed.

Expanding functions of a user system by installing a program is inherently implied in a system in which a program is installed in a user system

In referring to claim 17,

- Said user system is any of a personal computer, a portable terminal, and a complex digital image forming apparatus:

Oki, Fig. 2 shows the user system is a portable terminal

In referring to claim 18,

- Said server further includes list generating means for generating a program list made up of programs which can be supplied to the user system, and transmits the program list via the network to the user system; said user system displays the program list on the display means, and selects a program from the program list according to operation on the operation input means:

Oki, col. 5, lines 14-20 (see full quote above)

In referring to claim 19,

- Said server further includes list generating means for generating a program list made up of programs which are operable in the operating environment of the user system; transmits the program list via the network to the user system, and said user system displays the program list on the display means and selects a program from the program list according to operation on the operation input means:

Oki, Fig. 4 shows requesting a list from the server S10, generating a list at the server, receiving and displaying the list S12, and selecting a program from the list S12

In referring to claim 20,

- Said server stores the result of judgment by the operation judging means when the program is judged to be inoperable:

Storing the result of a judgment made in a server is inherently implied in a server that conducts said judgment

In referring to claim 21,

- Operating environment judging means for judging an operating environment of the user system; user-side communication means for transmitting data to and receiving data from the server via the network:

Oki, col. 2, lines 33-36 (see full quote above)

- Server-side communication means for transmitting data to and receiving data from the user system via the network; operation judging means for judging whether a program can be operated or not in the operating environment of the user system received via the server-side communication means:

Oki, col. 2, lines 37-44 (see full quote above)

- Said user system is operable to Execute the program on the user system after the program is supplied from the server and installed on the user system to thereby confirm operation of the program:

The purpose of the system of Oki is to download new software to be executed on the client. Executing the software is inherently implied in the system of Oki

In referring to claim 23,

- Transmitting by a user system an order for a program via a network to a server;
Oki, Fig 3 shows selecting software at step S12
- Receiving the program in response to the order from the server via the network;
Oki, Fig. 5 shows receiving the program at S17 in response to the selection
- Confirming operation of the program; transmitting a notification of operation confirmation via the network to the server so as to allow the server to confirm an operation state of the program:

Oki, Fig. 5 shows the confirming of decompression, moving/re-naming files and registration, signifying the operation of the program

In referring to claim 24,

- User-side operation judging means for confirming operation of the program; operation confirmation notification transmitting means for transmitting a notification of operation confirmation to the server so as to allow the server to confirm an operation state of the program:

Oki, Fig. 5 shows the confirming of decompression, moving/re-naming files and registration, signifying the operation of the program

In referring to claim 26,

- A computer-readable recording medium having a program for executing the program receiving method of claim 1 recorded thereon:
A computer-readable recording medium having a program for executing the program is inherently implied in the computer system of Oki

In referring to claim 27,

- A computer-readable recording medium having a program for executing the program receiving method of claim 23 recorded thereon:
A computer-readable recording medium having a program for executing the program is inherently implied in the computer system of

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Platt (U.S. Patent Number 5,421,009, hereinafter “Platt”). Platt discloses a method of remotely installing software directly from a central computer. Platt shows,

In referring to claim 21,

- Operating environment judging means for judging an operating environment of the user system:

Platt, Fig. 8 shows checking the operating system level at step 816

- User-side communication means for transmitting data to and receiving data from the server via the network:

Platt, Fig. 8 shows a bi-directional connection 106 from a server 108 to a client 110 at step

- Server-side communication means for transmitting data to and receiving data from the user system via the network:

Platt, Fig. 8 shows a bi-directional connection 106 from a server 108 to a client 110 at step

- Operation judging means for judging whether a program can be operated or not in the operating environment of the user system received via the server-side communication means:

"In the same manner as block 812 checked the hardware and limits the installation to certain types of hardware, block 816 limits the installation to certain types and levels of operating systems." (Platt, col. 6, lines 32-36)

Platt, Fig. 8 shows checking the operating system level at step 816 and generating an error message if it won't operate on the user system

- Said user system is operable to Execute the program on the user system after the program is supplied from the server and installed on the user system to thereby confirm operation of the program:

The purpose of the system of Platt is to download new software to be executed on the client. Executing the software is inherently implied in the system of Platt

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-11, 22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oki in view of Alexander et al. (U.S. Patent Number 6,134,593, hereinafter "Alexander").

In referring to claim 8, Oki shows substantial features of the claimed invention including receiving by a server an order for a program via a network from a user system; transmitting a program in response to the order via the network to the user system: Oki, Fig. 4 shows selecting a program **S12**, checking if the program is operable at **S14**, Fig. 5 shows transmitting the selected program at **S18**

However, Oki does not show asking a user to pay for the program after confirming the operation of the program. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Oki as evidenced by Alexander.

In analogous art, Alexander discloses automated method for electronic software distribution. Alexander shows asking a user to pay for the program after confirming that the program is operable in the user system: Alexander, Fig. 3 shows paying for the software at **345** after installing said software at **305**

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Oki so as to asking a user to pay for the program after confirming the operation of the program, such as taught by Alexander, in order to obtain a profit for providing software.

In referring to claim 9, Oki in view of Alexander shows,

- Requesting the user system by the server to inform the server of an operating environment via the network:

"The circumstance information informing unit obtains circumstance information relating to software operation circumstances in the terminal equipment and informs the distributing center of them." (Oki, col. 2. lines 33-36)

In referring to claim 10, Oki in view of Alexander shows,

- Generating by the server a program list made up of programs which are operable in the user system and which can be provided by the server; providing the program list via the network to the user system:

"When the user inquires of the host computer 21 for the keyword lists through the terminal 23, the host computer 21 transmits' the first and second key tables 32 and 33 successively and displays keywords included in them on the display 24 of his terminal 23. The user selects the displayed keywords which corresponds to the target software and informs the host computer 21 of his selection." (Oki, col. 5, lines 14-20)

In referring to claim 11, Oki in view of Alexander shows,

- Storing by the server an operating environment of the user system:
Receiving user data and running a script on said user data (Oki, Fig.4, S14 and 40)
inherently implies a storing means to store said user data

In referring to claim 22, Oki shows substantial features of the claimed invention including: server-side operation judging means for confirming an operation state of the program in the user system: Oki, Fig. 5 shows the confirming of decompression, moving/re-naming files and registration, signifying the operation of the program.

However, Oki does not show asking a user to pay for the program after confirming the operation of the program. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Oki as evidenced by Alexander.

In analogous art, Alexander discloses automated method for electronic software distribution. Alexander shows asking a user to pay for the program after confirming that the program is operable in the user system: Alexander, Fig. 3 shows paying for the software at 345 after installing said software at 305

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Oki so as to asking a user to pay for the

program after confirming the operation of the program, such as taught by Alexander, in order to obtain a profit for providing software.

In referring to claim 25, Oki shows substantial features of the claimed invention including

- Server-side operation judging means for confirming an operation state of the program in the user system; and user-side operation judging means for confirming operation of the program; and operation confirmation notification transmitting means for transmitting a notification of operation confirmation to the server so as to allow the server to confirm an operation state of the program:

Oki, Fig. 5 shows the confirming of decompression, moving/re-naming files and registration, signifying the operation of the program

- Where the program supply system and the program receiving apparatus are connected to each other via a network:

Oki, Fig. 2 shows the program supply system 21 and the program receiving apparatus 23 are connected to each other via a network 22

However, Oki does not show asking a user to pay for the program after confirming the operation of the program. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Oki as evidenced by Alexander.

In analogous art, Alexander discloses automated method for electronic software distribution. Alexander shows asking a user to pay for the program after confirming that the program is operable in the user system: Alexander, Fig. 3 shows paying for the software at 345 after installing said software at 305

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Oki so as to asking a user to pay for the program after confirming the operation of the program, such as taught by Alexander, in order to obtain a profit for providing software.

Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oki in view of

Thomas (U.S. Patent Number 4,446,519, hereinafter "Thomas"). Although Oki shows substantial features of the claimed invention, Oki does not show sending notification to the server when the program is executed. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Oki as evidenced by Thomas.

In analogous art, Thomas discloses a method and apparatus for providing security for computer software. Thomas Fig. 1 shows sending a message to a security device after the program begins execution.

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Oki so as to notify the server when the program is operating, such as taught by Thomas, in order to provide security for said program.

Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett (U.S. Patent Number 6,073,214, hereinafter "Fawcett") in view of Merkle et al. (U.S. Patent Number 6,330,549, hereinafter "Merkle").

In referring to claim 31, Fawcett shows substantial features of the claimed invention, including:

- Sending to the server operating environment data of the user system:
Fawcett, Fig. 4A, step 70
- Receiving from the server a list of programs that is generated based on the operating environment data:
Fawcett, Fig. 4A, step 76
- Sending to the server a request for one of the programs selected from the list; receiving the selected program from the server; installing the received program:
Fawcett, Fig. 4A, step 94
- Executing the program to confirm its operation:

The purpose of the system of Fawcett is to download new software to be executed on the client. Executing the software is inherently implied in the system of Fawcett. However, Fawcett does not show sending to the server a notification regarding the confirmation of operation. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Fawcett as evidenced by Merkle.

In analogous art, Merkle discloses protected shareware. Merkle shows requesting usage authorization while the program is running (Merkle, Fig. 3).

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Fawcett so as to send to the server a notification regarding the confirmation of operation, such as taught by Merkle, in order to allow the server to extend the functionality of the software.

In referring to claim 32, Fawcett in view of Merkle shows,

- Receiving a request for payment for the program from the server after the sending of notification:

Merkle Figs. 3-5 show running the program (Fig. 3), then requesting extended functionality (Fig. 3), billing the user (Fig. 5), and finally providing extended functionality (Fig. 3).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Klinger whose telephone number is (571) 272-3955. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott M. Klinger
Examiner
Art Unit 2153

smk



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SUPERVISORY PATENT EXAMINER
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